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THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 10/718,086 Confirmation No. 9418
Applicant : Reade Clemens
Filed : November 19, 2003
TC/A.U. : 3724
Examiner : Phong H. Nguyen

Docket No. : 085-10546A(01-465A)
Customer No. : 52237

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

REPLY BRIEF

Sir:

This is in response to the Examiner's Answer mailed October 10, 2006, setting a two month period for response which expires on Sunday, December 10, 2006.

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS

On page 6 of the Examiner's Answer, in response to Appellant's argument that the rejection under Section 112, first paragraph, is faulty, the Examiner makes the following statement:

"The Examiner clearly provided his doubts why one of ordinary skill in the art could not make or use the claimed invention...."

Appellant submits that the Examiner has failed to make a showing sufficient to establish lack of enablement. The Examiner's "doubts" are not the standard by which one determines whether a disclosure is enabling. It is submitted that the Examiner has not set forth a proper line of technical reasoning why one of ordinary skill in the art could not make and use the claimed invention without undue experimentation. In fact, the Examiner's rejection does not even contain any statement as to what is the level of skill in the art. Without such a statement, there can be no conclusion that one of ordinary skill in the art could not make and use the claimed invention given the information provided in the specification. As noted in Appellant's Brief, the Examiner must explain why he doubts the truth or accuracy of any statement in the supporting disclosure and to back up assertions of his own with acceptable evidence or reasoning which is inconsistent with the contested statement. The Examiner has failed to point to any statement which he considers to be untrue or inaccurate. Still further, the Examiner fails to recognize that even if some

experimentation were needed to make the tool specified in the claim that such experimentation is permissible. The Examiner has not made any statement why such experimentation would be "undue."

On pages 6 - 9 of the Examiner's Answer, the Examiner contends that Appellant does not provide enough information of the <17, 12, 24> direction so that one of ordinary skill in the art can make and use the claimed invention. Appellant submits that one of ordinary skill in this art does not require anything more than the identification of the direction which has been provided to make and use the claimed invention. For example, one of ordinary skill in the art would know <17,12,24> refers to 17 units of length in the x direction, 12 units of length in the y direction, and 24 units in the z direction. Nothing more is needed. Similarly, one of ordinary skill in the art would know that the diamond is aligned along the axis 24. With respect to the Examiner's comments on page 9 of the Examiner's Answer about FIG. 3, the fact that FIG. 3 may not precisely show <17,12,24> is irrelevant to the discussion since the location is specifically identified in the figure and in the written description.

With respect to the Examiner's comments about claim 1, the claim clearly calls for the diamond to be mounted to the tip end within 8 degrees of a <17,12,24> direction. It is submitted that one of ordinary skill in the art would know how to do this. The

fact that the Examiner may not understand how to do this is irrelevant to the enablement issue.

With respect to the Examiner's comments about Anderson et al. on page 10 of the Examiner's Answer, one can not ignore a claim limitation in making a rejection. There is no express disclosure in Anderson et al. of mounting the diamond to a tip end of a shank within 8 degrees of a <17, 12, 24> direction. Thus, Anderson et al. could not possibly anticipate claims 1 - 6 and 8 - 14 in the application. An anticipation rejection may not be based upon conjecture or speculation. It is submitted that what the Examiner considers the reference to disclose is not a proper basis for forming an anticipation rejection because it is nothing more than conjecture and speculation. The Examiner in making an anticipation rejection must point to a specific place in a reference where the claim limitation is expressly or inherently disclosed. This the Examiner has not done.

As for the Examiner's comments in the second paragraph on page 10 of the Examiner's Answer that the single crystal diamond limitation of claims 5 and 6 is considered to be met by a tip covered with a diamond coating, such comment defies logic. Anderson et al. never says that any diamond is a single crystal diamond. Thus, it can not be said to anticipate such a claim limitation. Again the Examiner is engaging in impermissible conjecture and speculation.

With regard to the third paragraph on page 10 of the Examiner's Answer, the Examiner misstates the argument. The argument is that Anderson et al. does not teach or suggest securing a diamond to an end of the shank with a braze material. The Examiner does not even attempt to point out where Anderson et al. discusses a braze material. Absent such a disclosure, Anderson et al. can not be said to teach or suggest this claim limitation.

With regard to the Examiner's arguments in the fourth paragraph on page 10 of the Examiner's Answer, the Examiner has not presented a proper inherency rejection. The Examiner has made no showing that the claimed subject matter is necessarily present in the reference and/or that one of ordinary skill in the art would recognize that it is present in the reference.

With respect to the Examiner's comments in the second paragraph on page 11 of the Examiner's Answer, while Anderson et al. may disclose steel, there is no disclosure of either hardened tool steel or stainless steel in column 5, lines 5 - 10. There is also no disclosure of a head wider than the shank at a second end in FIG. 8 of Anderson et al. This is clearly evidenced by the Figure shown on page 12 of the Examiner's Answer where it can be clearly seen that what the Examiner has determined to be a head is in fact not a head. As mentioned before, there is no disclosure of a single crystal diamond in Anderson et al. Again, the Examiner's conclusion that a diamond coating on an indenting tip meets the single crystal diamond

limitation in the claims defies logic. As for the inherency argument that there is a diamond disclosed in Anderson which meets the limitations of claim 8, the Examiner has not made out the required case for establishing inherency. There is no discussion as to why this claimed feature is necessarily present in Anderson et al. and/or how one of ordinary skill in the art would recognize it as being present. The Examiner has provided no extrinsic evidence on this point. As for claim 9, FIG. 3 in Anderson et al. does not establish that the diamond has a 90 degree or a 120 degree included angle. Referring now to page 13 of the Examiner's Answer, the only thing shown by the figures is that the conical tip has a 90 degree angle in one figure and an unknown angle in the second figure. However, the claim calls for the diamond to have the claimed angles and the Examiner has failed to point where Anderson et al. says that any diamond in the coating has the claimed angles. In fact, no figure in Anderson et al. shows the construction of the applied diamond coating. As for the subject matter of claim 10, the Examiner has failed to point exactly where in the Abstract and column 3, lines 29 - 54, Anderson et al. discloses a brazing alloy which wets both the diamond and the material forming the shank. There is no disclosure of a brazing alloy in the cited portions of Anderson et al.

With respect to the Examiner's argument at the top of page 14 of the Examiner's Answer, the mere fact that a claimed feature may

exist in the prior art is not a basis for reaching an obviousness conclusion. Anderson et al. is clear that he uses a diamond coating. There is absolutely no reason why Anderson et al. would want to replace the entire tip structure including the diamond coating by a synthetic single crystal diamond. The Roberts patent does not provide any teaching or suggestion which would cause one of ordinary skill in the art to modify Anderson et al. as the Examiner suggests. Thus, the obviousness rejection of claim 7 must fail. The rejection also fails because the Roberts patent would not cure the aforementioned deficiencies of Anderson et al.

CONCLUSION

For the reasons set forth in Appellant's Appeal Brief and the instant Reply Brief, the Board is respectfully requested to reverse the rejections of record and remand the application to the Primary Examiner for allowance and issuance.

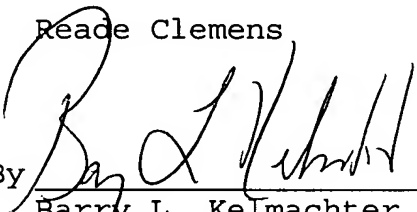
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No fee is believed to be due as a result of this response.
Should the Director determine that a fee is due, he is hereby
authorized to charge said fee to Deposit Account No. 21-0279.

Respectfully submitted,

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IN TRIPLICATE

Date: December 11, 2006

I, Karen M. Gill, hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on December 11, 2006.

